

REMARKS

Reconsideration of this application and the rejection of claims 33, 34, 36, 37, 39-41 and 43 are respectfully requested. Applicants have attempted to address every objection and ground for rejection in the Office Action dated May 17, 2006 (Paper No. 05152006) and believe the application is now in condition for allowance. The claims have been amended to more clearly describe the present invention.

Claims 33, 34, 36, 37, 39-41 and 43 stand objected to because the limitation "at least one of a channel and a depression" is recited several times, and the Examiner contends that the limitation should recite "at least one of a channel or a depression," because the specification refers to the alternative in this manner. Accordingly, Applicants have amended claims 33, 36 and 39, replacing "at least one of a channel and a depression" with "at least one of a channel or a depression," and therefore respectfully traverse the objection of claims 33, 34, 36, 37, 39-41 and 43.

Claims 33, 34, 36, 37 and 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over French (U.S. Pat. No. 5,020,256). French discloses a handrail 1 for an escalator having a groove or recess 3 in an upper portion thereof. An advertisement 14 is placed within the groove 3 and is illuminated from underneath by a photo luminescent light source. A cover 6 is placed over the advertisement to protect it from damage and dirt.

French neither discloses nor suggests all of the features recited in amended claims 33 and 39, from which the remaining claims depend. Specifically, the Examiner contends that it would have been obvious to modify French by removing the cover and its attended function. Applicants respectfully disagree.

First, Applicants respectfully submit that there is no incentive or motivation to modify French as suggested by the Examiner. In each of its embodiments, French explicitly discloses providing a cover to protect the advertisement from dirt and scratches due to continued use, thereby reducing the need to continually replace the advertisement. Modifying French by removing the cover would render French unsatisfactory for its intended purpose, which is to provide an escalator handrail with an advertisement located therein and covered in order to increase its durability and use.

Further, the test to be considered when determining obviousness is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. Applicants respectfully submit that in French, the problem to be solved is how to provide an illuminated advertisement in an escalator handrail that is protected and durable enough to last an extended amount of time. French solves this problem by providing a cover over the advertisement material, protecting it from dirt and scratches during use of the escalator. As stated above, removing the cover would be unsatisfactory to the purpose of

French's product. Accordingly, Applicant respectfully submits that based on the above, modifying French to remove the cover would not have been suggested to those of ordinary skill in the art.

Claims 33, 34, 36, 37 and 39-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Glatz et al. (U.S. Pat. No. 5,904,017) in view of Tassey et al. (U.S. Pat. No. 6,237,266). Glatz discloses a photo luminescent safety accessory or tread cover 100 including a photo luminescent strip 114 adhered thereto. The strip 114 is arranged level with the tread cover 100. Tassey discloses a baseboard-mounted evacuation aid having photo luminescent indicators 20 that are preferably located on a strip of vertically arranged carpet 12 to have a surface 22 that is either recessed below or raised above a surface 24 defined by carpet fibers 16. (Col. 4, ll. 34-44). The photo luminescent indicators 20 are embroidered into the carpet using a photo luminescent filament 26. (Col. 4, ll. 54-56). The filament 26 has a different texture than the carpeting 12, and accordingly users can differentiate the photo luminescent thread from the carpeting by both sight and touch.

Applicants submit that neither Glatz nor Tassey, either alone or in combination, discloses or suggests all of the features recited in amended claims 33 and 39, from which the remaining claims depend. The Examiner contends that it would have been obvious to modify Glatz so that the photo luminescent material is located below the top surface of the tread cover, as taught by Tassey. Applicants respectfully disagree.

Applicants submit that there is no incentive or motivation to modify Glatz as suggested by the Examiner. Specifically, in Glatz, the photo luminescent material is located level with the channel to allow people to easily see the material and evacuate in an emergency situation. Further, the photo luminescent material is co-extruded and integrally formed with the substrate, providing a smooth and continuous product. If Glatz were modified so that the material was recessed in the channel, dust and dirt could eventually become trapped in the channel, making it more difficult to see the exit routes. Accordingly, Applicants submit that such a modification would render Glatz unsatisfactory for its intended purpose of providing an easily seen escape route in an emergency.

Further, Applicants submit that the combined teachings, knowledge of one or ordinary skill in the art, and the nature of the problem to be solved as a whole would not have suggested modifying Glatz so that the photo luminescent material is located below the top surface of the tread cover. Rather, as stated above, Glatz arranges the photo luminescent material level with the tread cover to ensure that the material can be easily seen during an emergency evacuation. Modifying Glatz as suggested by the Examiner could render it more difficult for the photo luminescent material to be seen, because it will be located below the surface of the substrate, and accordingly Applicants submit that such a modification would not have been suggested to one of ordinary skill in the art.

Further, Applicants submits that Tassey does not provide a channel in which the photo luminescent material is located. Rather, the photo luminescent material is embroidered into the carpeting 12, and is distinguished from the carpeting 12 by its luminescence and also by its texture. (see Tassey, col. 4, ll. 34-44). Accordingly, the photo luminescent material in Tassey is a thread that is separately embroidered into the carpeting 12. In contrast, the photo luminescent material in Glatz is a strip of smooth material that is co-extruded with the substrate and integrally formed with the substrate channel. (see Glatz, col. 4, ll. 1-3). Applicants submit that one of ordinary skill in the art would not combine the teachings of Glatz and Tassey and modify Glatz to include embroidered photo luminescent thread in the substrate channel. First, such a combination would prevent the photo luminescent material from being co-extruded and integrally formed with the substrate. Further, this combination would prevent the product from having a smooth, flush surface, which is generally aesthetically pleasing to users. Also, there is no incentive or motivation to combine the references in such a manner.

Finally, Applicants admit that Tassey recognizes the problem of how to provide a photo luminescent evacuation aid that is aesthetically pleasing, which was also addressed in the present application. However, as indicated in the Affidavit of commercial success that is discussed in further detail below, the present application has provided a commercially successful solution to the problem of aesthetics addressed in Tassey. Applicants submit that if Glatz and

Tassey were to be combined as suggested by the Examiner, the resulting product would detract from the aesthetic presentation of Glatz, further discouraging any suggestion of combination, or in addition, such a combination would not be aesthetically pleasing to users, because it would include a substrate having a smooth surface and a photo luminescent thread separately embroidered into the substrate channel.

Accordingly, based on the above arguments and remarks, Applicants respectfully traverse the rejection of claims 33, 34, 36, 37 and 39-41 under 35 U.S.C. §103(a) based on Glatz and Tassey.

Claim 43 stands rejected under 35 U.S.C. §103(a) as being unpatentable over either French or Glatz in view of Tassey, and further in view of the Applicants' discussion of the prior art. The arguments made above traversing French, Glatz and Tassey are reasserted here.

Applicants submit that none of French, Glatz, Tassey, or the Applicants' discussion of the prior art, disclose or suggest all of the features recited in amended claim 39, from which claim 43 depends. Also, Applicants submit that there is no incentive or motivation to combine the references and Applicants' disclosure as suggested by the Examiner. Applicants further submit that in view of the arguments made above with respect to claim 39, claim 39 is in allowable form, and Applicants respectfully traverse the rejection of claim 43 based on 35 U.S.C. §103(a).


In accordance with 37 C.F.R. §1.132, Applicants herewith submit an Affidavit signed by George Trevor Dimond, the first-named inventor in the above-identified application, as evidence of the commercial success of the photo luminescent pigment application claimed in the above-identified application. Specifically, the photo luminescent pigment application recited in the claims has been installed worldwide with over three hundred cites in North America, including the Time Warner Center in New York City, which has approximately 80,000 linear feet of the claimed photo luminescent pigment application within the building. The claimed product has also been installed in seven buildings in Toronto, Canada, with over 20,000 steps having the pigment, and the Melbourne Cricket Ground in Melbourne, Australia, where over 25,000 steps have been installed with the photo luminescent pigment application.

The Affidavit further attests that the pigment produced in accordance with the above-identified application is more durable and cost efficient than competing products, because it is resistant to dirt and commercial cleaners, thereby lasting longer than current pigments and only requiring a one-time purchase from consumers. Such a cost saving advantage is significant in the high volume of the product that is generally installed in each project. Accordingly, in view of the attached Affidavit, Applicants respectfully submit that the evidence of commercial success of the above-identified photo luminescent pigment application traverses the obviousness rejections raised by the Examiner.

In view of the above amendments, the application is respectfully submitted to be in allowable form. Allowance of the rejected claims is respectfully requested. Should the Examiner discover there are remaining issues which may be resolved by a telephone interview, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By 
Rebecca L. Uryga
Registration No. 53,713

Customer No. 24978

August 17, 2006
Suite 2500
300 S. Wacker Drive
Chicago, Illinois 60606-6501
Telephone: (312) 360-0080
Facsimile: (312) 360-9315